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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/668,039	09/21/2000	William J. Beyda	00P7906US	9089
7590	04/15/2004			EXAMINER JAROENCHONWANIT, BUNJOB
Siemens Corporation Intellectual Property Department 186 Wood Avenue South Iselin, NJ 08830			ART UNIT 2143	PAPER NUMBER
DATE MAILED: 04/15/2004				5

Please find below and/or attached an Office communication concerning this application or proceeding.

PAG

Office Action Summary	Application No.	Applicant(s)
	09/668,039	BEYDA, WILLIAM J.
	Examiner	Art Unit
	Bunjob Jaroenchonwanit	2143

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 10 March 2004.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-5, 14-18 and 29-32 is/are pending in the application.
 - 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-5, 14-18 and 29-32 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 21 September 2000 is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

- 13) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
 - a) The translation of the foreign language provisional application has been received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- | | |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ . | 6) <input type="checkbox"/> Other: _____ . |

DETAILED ACTION

1. Applicant's election without traverse of Invention group I claims 1-5, 14-18 and 29-32 in Paper No. 4 is acknowledged. The elected claims have been reviewed; the objections and rejections cited are as stated below.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-3, 5, 14-16, 18 and 29 are rejected under 35 U.S.C. 102(b) as being anticipated by Tsumura (US. 5,842,023).

4. Regarding claims 1, 14 and 29, Tsumura discloses, a method, apparatus and program (hereinafter collectively referred to as a "system"), for an electronic messaging system, comprising an access restriction filter configured to interrogate an electronic message for an access restriction notice in response to a user command to transmit the electronic message, and to respond to a detected access restriction notice in accordance with a prescribed transmission policy (see fig 2, 4, and 5; Col.12, lines 13-63; Col. 16, line 40-Col. 17, line 37, Col. 20, lines 1-39).

5. Regarding claims 2, 3, 15 and 16, Tsumura discloses, the system of claim 2, wherein the access restriction filter is configured to detect a copyright notice in the electronic message (see fig 2, 4, and 5; Col.12, lines 13-63; Col. 16, line 40-Col. 17, line 37, Col. 20, lines 1-39).

6. Regarding claims 5, 18, Tsumura discloses, the system of claim 3, wherein the access restriction filter is configured to detect a copyright notice by interrogating a header component of the electronic message (see fig. 2 and 5, in blocks 21-24 represent a header of multimedia digital information in main body information in block 24; the copyright information is in block 23, see detail in fig. 5).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

- (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 4 and 17 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Tsumura et al., (U.S. 5,842,023) as applied to claims 3 and 16, in view of Nakagawa et al, (US 2003/0159065).

9. Regarding claims 4 and 17, Tsumura discloses the invention substantially, as claimed, as described in their base claims, but silent to comparing characters in the electronic message to a copyright notice representation. However, in an analogous art, Nakagawa teaches a system for inspecting the copyright of electronic data in a network, which is capable of detecting, comparing characters with copyright notice representation (Fig. 1, 4, 7-9; paragraphs 6-7, 48).

Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to expand Tsumura system's utility with Nakagawa's idea, with the motivation of improving copyright protection, adequately (paragraph 7).

10. Claims 30-32 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Tsumura et al, as applied to claim 1 and 14 above.

11. Regarding claims 30-32, Tsumura discloses, a system that capable of detecting ownership restriction component, e.g., copyright, from electronic messages, but fails to explicitly include detecting, other types of owner restriction, e.g., confidential. However, applying Tsumura's system, which readily capable of detecting copyright information, to detect confidential information, would have been obvious to one of ordinary skill in the art at the time of the invention was made that was a matter of implementation and design choice, which required minimum alteration and does not produce any unexpected result.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bunjob Jaroenchonwanit whose telephone number is (703) 305-9673. The examiner can normally be reached on 8:00-17:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wiley can be reached on (703) 308-5221. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2143

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Bunjob Jaroenchonwanit
Primary Examiner
Art Unit 2143

/bj